The opinion in support of the decision being entered today was <u>not</u> written
for publication and is <u>not</u> binding precedent of the Board.


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> ROBIN A. GREEN

Appeal No. 2006-1016
Application No. 09/176,077

ON BRIEF
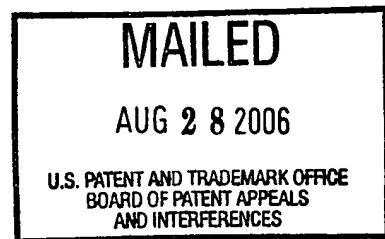
Before KRASS, RUGGIERO, and MacDONALD, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on appeal from the final rejection of claims 1-8, 10, 11, 13-20,

33-38, and 40. Claims 21-32, 39, and 41 have been indicated by the examiner as being

directed to allowable subject matter and are not before us on appeal.

The invention pertains to interactions of users through a web browser, wherein

comments are permitted to be added to documents and displayed dynamically.

Representative independent claim 1 is reproduced as follows:

1. A file review system for storing and managing a set of comments associated
with a source file, comprising

means for requesting the source file using unmodified standard messaging
protocols,

means for accepting data from the source file and storing a representation of the source file as a markup file,

means for creating a comment file containing data representing the set of comments associated with the source file,

means for accepting new comments for inclusion in the set of comments associated with the source file and for updating the comment file to correspond to the complete set of comments,

means for generating a hypertext document from the markup file and from the comment file, the hypertext document corresponding to the source file and including portions corresponding to one or more of the set of comments associated with the source file,

means for communicating the hypertext document to a user for display.

The examiner relies on the following references:

Gramlich	5,826,025	Oct. 20, 1998
Tran	6,054,990	Apr. 25, 2000 (filed July 05, 1996)
Day et al. (Day)	6,243,722	Jun. 05, 2001 (filed Nov. 24, 1997)

Claims 1-8, 10, 11, 13-20, 33-38, and 40 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Gramlich and Day with regard to claims 1, 10, 16-20, 33, and 40, adding Tran with regard to claims 2-8, 11, 13-15, and 34-38.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the

examiner is expected to make the factual determinations set forth in Graham v, John

Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate

reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430,

1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching,

motivation, or suggestion of a motivation to combine references relied on as evidence of

obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the

examiner's own understanding or experience – or on his or her assessment of what

would be basic knowledge or common sense. Rather, the examiner must point to some

concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d

1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only

assure that the requisite findings are made, based on evidence of record, but must also

explain the reasoning by which the findings are deemed to support the examiner's

conclusion. However, a suggestion, teaching, or motivation to combine the relevant

prior art teachings does not have to be found explicitly in the prior art, as the teaching,

motivation, or suggestion may be implicit from the prior art as a whole, rather than

expressly stated in the references. The test for an implicit showing is what the

combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the

art. In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re

Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift,

298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the

examiner are an essential part of complying with the burden of presenting a prima facie

case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444

(Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to

overcome the prima facie case with argument and/or evidence. Obviousness is then

determined on the basis of the evidence as a whole and the relative persuasiveness of

the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed.

Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984);

and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only

those arguments actually made by appellant have been considered in this decision.

Arguments which appellant could have made but chose not to make in the brief have

not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)

(2004)].

With regard to independent claim 1, the examiner asserts that Gramlich teaches

storing and managing a set of annotation overlays (Abstract, column 2, line 65 to

column 3, line 2, and 9-13) which the examiner compares to the claimed preamble of

"storing and managing a set of comments associated with a source file."

The examiner cites Figure 1, column 2, line 65 to column 3, line 2, and column 4,

lines 42-46 and 61-64, of Gramlich, teaching a Web browser used to request source

files via a source message. The examiner notes that while the original document is

requested using unmodified protocols (HTTP) in Gramlich, Gramlich does not

specifically teach that the requests to the overlay sources (Figure 1, item 116) are sent

using unmodified protocols. The examiner turns to Day, in the abstract; Figures 6 and

7; column 4, lines 18-25; column 5, lines 45-49; column 7, lines 22-38; and column 8, lines 53-60, for a teaching of a comment review system whereby comments are entered and stored separately from the original document, the comments sent utilizing a typical browser using typical protocols. The examiner equates this to the claimed "means for requesting the source file using unmodified standard messaging protocols."

The examiner concludes that it would have been obvious to apply Day's unmodified browser's use of sending comments, to Gramlich's sending of source data to the annotation proxy (see Gramlich's Figure 1, items 114 and 116), "providing Gramlich the benefit of capitalizing on the ubiquity of (typical) web browsers (see Day column 7 lines 27-28)" (answer-page 4).

Moreover, the examiner indicates that Gramlich does not specifically teach a "file review system," as claimed, but contends that since Gramlich suggests the importance of Web users to be able to comment on the content of a Web document, as well as view others' comments, providing the equivalent of the claimed "file review system," it would have been obvious "to interpret Gramlich's system to be used for document review purposes, providing the benefit of critical review of published documents" (answer-page 4).

The examiner also contends that Gramlich teaches the claimed "means for accepting data from the source file...source file as a markup file," by retrieving source documents in a Web browser (indicative of an HTML file) at column 3, lines 65-67, column 4, lines 43-50, and in the abstract.

The claimed "means for creating a comment file containing data...comments associated with the source file" is said to be taught by Gramlich as annotation overlay groups encapsulating annotation overlays associated with a source document file, at column 3, lines 9-13 and column 11, lines 54-61.

The claimed "means for accepting new comments for inclusion . . . to correspond to the complete set of comments" is said to be taught by Gramlich as input and acceptance of new annotation overlays directly to one or more overlay groups and as a grouped set of overlays associated with a document, wherein overlay groups are updated with new contributions accordingly, identifying column 7, lines 35-45 and column 8, lines 40-50, of Gramlich.

The examiner identifies Gramlich's teaching of a source document in a Web browser, indicative of an HTML file, (abstract; column 3, lines 65-67; and column 4, lines 43-50), as well as associated annotation overlays, with the overlays also written in HTML (column 8, lines 35-40), and Gramlich's teaching of an annotation overlay proxy (AOP), which dynamically combines a source document with associated annotation overlays, allowing the resulting merged document to be shown via a browser by directly displaying the inserted overlay text at the insertion point within the source document (column 11, lines 25-29; column 12, lines 34-36; column 13, lines 8-16; and Figure 5), as a disclosure of the claimed, "means for generating a hypertext document from the markup file...the set of comments associated with the source file."

Finally, the examiner asserts that Gramlich's teaching of a display of a merged

hypertext document via a browser (abstract; column 3, lines 17-22; and column 4, lines

43-47) is a disclosure of the claimed, "means for communicating the hypertext

document to a browser for display."

Appellant argues that the examiner has not provided sufficient motivation to

combine Gramlich and Day (principal brief, pages 5-7). Also, while appellant argues

specific limitations of dependent claims 16, 17, and 19 (principal brief, pages 8-10), no

argument is made that the combination of Gramlich and Day lacks any limitation of

claims 1, 10, 18, 33, and 40. Accordingly, if we find that there was sufficient motivation

for making the proposed combination of Gramlich and Day, then we would sustain the

rejection of these claims since appellant offers no further argument as to them.

We REVERSE.

We have reviewed the various portions of Day cited by the examiner (the

abstract; Figures 6 and 7; column 4, lines 18-25; column 5, lines 45-49; column 7, lines

22-38; and column 8, lines 53-60) for the proposition that Day discloses a means for

requesting a source file using "unmodified standard messaging protocols," as claimed,

but we find nothing therein convincing us of a disclosure of this limitation.

While appellant does not specifically deny the disclosure of such a limitation by

Day, appellant does assert that the examiner has provided no basis in fact to support

the assertion that by combining the rationale of Day, i.e., capitalizing on the ubiquity of

web browsers within development organizations, with the disclosure of Gramlich, one

would cause Gramlich's browsers to have a source call be considered an "unmodified standard messaging protocol," as claimed. We agree.

If there is some reason, unknown to us, to have combined the Day rationale of capitalizing on the ubiquity of web browsers within development organizations with Gramlich in such a manner to arrive at the instant claimed subject matter, including a "means for requesting the source file using unmodified standard messaging protocols," the examiner has not convincingly set forth such a reason.

Accordingly, we find no prima facie case of obviousness established by the examiner and we will not sustain the rejection of claims 1-8, 10, 11, 13-20, 33-38, and 40 under 35 U.S.C. § 103. The reference to Tran, employed in combination with Gramlich and Day in the rejection of claims 2-8, 11, 13-15, and 34-38 does not provide for the deficiencies of the primary references.

The examiner's decision is reversed.

<div align="center">REVERSED</div>

Errol A. Krass Administrative Patent Judge	)
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Joseph F. Ruggiero Administrative Patent Judge	) BOARD OF PATENT)) APPEALS AND
	) INTERFERENCES
Allen R. MacDonald Administrative Patent Judge	))
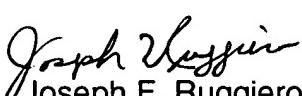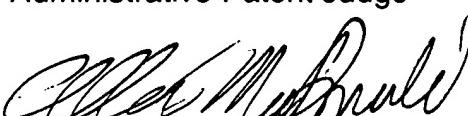
IBM Corporation
3039 Cornwallis Road
Dept. T81/B503, P.O. Box 12195
Research Triangle Park, NC 27709

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